

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1226/US	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]		Application Number 10/813,715	Filed March 31, 2004
On Signature _____		First Named Inventor Robert P. Morris	
Typed or printed name _____		Art Unit 2151	Examiner Saket K. Daftuar
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		/John A. Demos/	
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b)		John A. Demos	
is enclosed. (Form PTO/SB/96)		Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number 52,809		919-233-1942 x-219	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34		Telephone number	
		December 23, 2008	
		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of 1 forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection of claims 1-38 in the subject application. No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

Background

Claims 1-38 are pending in the present application, of which claims 1, 18, 35 and 37 are presented in independent form. Claims 1-38 stand finally rejected. Specifically, Claims 1-38 stand rejected as being anticipated by U.S. Patent No. 6,073,142 to Geiger, et

Reasons for Request

1. The Office has failed to show in a single prior art document, Geiger, the recited feature of "if the electronic message matches the criteria, displaying a graphic associated with the action when the electronic message is viewed at the client and executing the action if the graphic is selected" in its rejections of the independent claims, and improperly relies on conclusory statements without support from Geiger to reject the claims.

To support a rejection under 35 U.S.C. § 102, each and every feature of the claimed invention must be shown in a single prior art document. In re Paulsen, 30 F.3d 1475 (Fed. Cir. 1994); In re Robertson, 169 F.3d 743 (Fed. Cir. 1999). The pending claims positively recite limitations that are not disclosed (nor suggested) in the cited document. Specifically, claim 1 includes a recitation directed to "if the electronic message matches the criteria, displaying a graphic associated with the action when the electronic message is viewed at the client and executing the action if the graphic is selected." Geiger fails to disclose or even suggest such a recitation.

The Office cites Figure 19-20, blocks 1907,1909,1911,1913,1915 and the description found at column 23, lines 5-36 as disclosing the above referenced recitation. The cited sections of Geiger fail to disclose or suggest the above referenced recitation. The Office relies on the business rules disclosed in Geiger as anticipating the filter recitation of the instant claim. Specifically, the business rules in Geiger are directed to

gating. Geiger teaches "gating" (C7:9-13, C7:44-47) where one of the automatic actions is to send the mail for review to an administrator who is **NOT** the recipient.

Notwithstanding the above referenced deficiency of Geiger, Applicant will address the above referenced recitation with regard to the administrator views. The administrator can access the "gated" mail via an administrator client illustrated in Figures 19 and 20 and described in Column 9 lines 42-43, Column 10 lines 54-55, and Column 23 lines 58-60. Figure 19 illustrates a GUI showing a message list and Figure 20 illustrates a GUI presented after selection of a message from the message list for review. The buttons illustrated in each of Figures 19 and 20 are static buttons that are presented every time the sample screen in Figures 19 and 20 are presented. There is simply no teaching or suggestion in Geiger that the display of the buttons in either Figure 19 or Figure 20 is in any way related to matching a filter. Use of the buttons is at the discretion of the reviewer/administrator, and the buttons available are always present.

The graphic buttons in Geiger are displayed independent of the business rules disclosed in Geiger. For example, button 1907 is a review button. The review button merely allows a message to be reviewed in the screen illustrated in Figure 20. The review button itself is not presented based on the electronic message meets the criteria. Rather, this button is presented each time the sample screen illustrated in Figure 19 is shown. It is clear from the cited sections that the gatekeeper screen 1901 is displayed when the gatekeeper logs on. The gatekeeper screen 1901 displayed includes the buttons discussed above. As the buttons are displayed as part of gatekeeper screen 1901 at log on; the buttons cannot said to be displayed if the electronic message matches the criteria. In response to Applicant's arguments, the Office states "These buttons are displayed because the electronic message follow the rule to display all graphic buttons and one having ordinary skill in the art would clearly recognize this without any brief clarification."

The Office offers no support for the conclusory statement that "these buttons are displayed because the electronic message follows the rule to display all graphic buttons." There is simply no support for this conclusory statement in Geiger at all. The buttons shown in Figure 19 are displayed irrespective of the messages included in Figure 19. There is no suggestion, much less any teaching or disclosure, whatsoever of the buttons illustrated in Figure 19 being based on any rule. Further, such a conclusory statement cannot form a basis for a proper rejection under 35 U.S.C. § 102.

The Office continues, stating, "Note the 'review' graphic button is not displayed, it follows the rule to display other graphic buttons except 'review' and one having ordinary

skill in the art must recognize this.” The Office again offers no support for the conclusory statement that “it follows the rule to display other graphic buttons except ‘review’.” There is simply no support for this conclusory statement in Geiger at all. Figure 19 illustrates the GUI showing a list of messages presented upon login. Figure 20 illustrates a GUI that is presented upon selection of a message for review. It logically follows that the review button would not be shown in the review GUI illustrated in Figure 20. The buttons shown in Figure 20 are displayed irrespective of the message illustrated in Figure 20. There is no teaching whatsoever of the buttons illustrated in Figure 20 being based on any rule. Further, as stated above, such a conclusory statement cannot form a basis for a proper rejection under 35 U.S.C. § 102.

Accordingly, since Geiger fails to disclose each and every feature of the claimed invention for at least the above reasons, claim 1 is not anticipated by Geiger. Further, claims 18, 35 and 37 contain analogous recitations to those discussed above and are allowable for at least the same reasons. Furthermore, rejected claims 2-17, 19-34, 36, and 38 are novel and inventive for at least the same reasons.

2. The Office continues to improperly use a standard of “one having ordinary skill in the art” in rejecting the claims under 35 USC 102.

Further, the Office states that “one having ordinary skill in the art would clearly recognize this without any brief clarification.” The importance of a determination of the knowledge of one of ordinary skill in the art is pertinent for an obviousness rejection under 35 U.S.C. § 103. It is unclear to Applicant as to how such a determination can be used in a rejection under 35 U.S.C. § 102.

As stated above, to support a rejection under 35 U.S.C. § 102, each and every feature of the claimed invention must be shown in a single prior art document. Any analysis of the knowledge of one having ordinary skill in the art has no place in a rejection under 35 U.S.C. § 102. Applicant respectfully requests the Office reconsider and withdraw the rejection made under 35 U.S.C. § 102.

3. The Office has again failed to address various recited features in various dependent claims thus leaving the record insufficient for appeal.

As stated above, claims 3-5, 7-9, 11-12, and 14 are allowable for at least the same reasons stated above. Further, each of these claims contains additional recitations that are neither disclosed nor suggested by Geiger. Applicant presented arguments in the paper dated January 9, 2008 regarding the above referenced claims

and in the Pre-Appeal Brief Request for Review filed July 21, 2008. Even after reviewing the previously filed Pre-Appeal Brief Request for Review and issuing another Final Office Action, the Office yet again failed to address these arguments and simply repeated the text from the rejection made in the previous Office Action without noting Applicant's traversal of the rejection. MPEP section 707.07(f) requires the Office to answer all material traversed. Specifically, the section states, "where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Applicant respectfully requested the Office specifically address the below presented arguments. For each of the below listed claims, Applicant stated in previous communications "If the Examiner disagrees, the Examiner is requested to point out particularly where this feature is disclosed or suggested in the cited document." The Office has failed to address these arguments, and has thus left a record insufficient for appeal.

Specifically, claim 3 includes a recitation directed to "placing the electronic message with the action list in the recipient's inbox." The action cites Column 19, line 52 - column 21 line 24 of Geiger as anticipating this recitation. Applicant has reviewed Geiger and can find no reference in the cited section (or any other section for that matter) to "placing the electronic message with the action list in the recipient's inbox." As stated above, Geiger does not discuss a recipient inbox in any manner other than describing in the background, and e-mail client application by stating "e-mail client applications are end-user applications for creating, reading, and managing a user's individual e-mail account." This section cannot be said to anticipate "placing the electronic message with the action list in the recipient's inbox" as recited in claim 3. Further, claims 4 and 5 include recitations directed to "inserting computer code into the electronic message if the electronic message matches the criteria" and to "inserting a graphic associated with each action in the action list into the electronic message" respectively. The action cites "Figure 19-20, blocks 1907, 1909, 1911, 1913, 1915 are graphic buttons, column 23, lines 5-36" and "column 1, line 35 - column 2, line 14" of Geiger as anticipating these recitations. Applicant can find no reference in the cited section (or any other section for that matter) to "inserting computer code into the electronic message" or "inserting a graphic associated with each action in the action list into the electronic message." There is simply no discussion in Geiger of inserting computer code into a message or a graphic into an action list. Claims 7-9 and 14 each include recitations directed to actions taken at the client. The Action cites column 21, line 26 - column 22 line 10 and column 23, lines 5-36 as anticipating the recitations included in claims 7-9. Applicant can find no reference in the cited section (or any other section for that matter) to actions taken on the client. There is no reference to actions

taken at the client that receives the message. Claims 11-12 include recitations directed to "the criteria of the filter are customizable for a recipient" and "the action is customizable for a recipient." The Action cites "Figure 4B, for automatic and manual review with Figures 6-8 that shows different options to configure filters and rules" as anticipating the recitations described above. Applicant can find no reference in the cited Figures (or any other Figure or section for that matter) to criteria or actions customizable for a recipient. There is no reference to any recipient based customization. Figures 4B and 6-7 all describe actions and criteria that are based on the gatekeeper role and not the recipient. Figure 8 shows a GUI for creating rules based on message properties such as size and attachment size. There is simply no disclosure or suggestion of recipient based customization of criteria of the filter or of an action in Geiger.

As stated above, Applicant has presented arguments regarding the above referenced claims, that the Office has failed to address and simply repeated the text from previous rejections without noting Applicant's traversal of the rejection. As stated above, MPEP section 707.07(f) requires the Office to answer all material traversed. Applicant has respectfully requested the Office specifically address the above presented arguments. The Office has repeatedly failed to address these arguments, and has thus left a record insufficient for appeal.

Summary

As stated above, the record fails to address the recitation in the claims of 1-38. Moreover, Applicants respectfully assert that these features are absent from the cited documents. Accordingly, the rejection of independent claims 1, 18, 35 and 37 should be withdrawn and the application should be passed to issue.

Respectfully submitted,

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